

REMARKS

In this response to the above identified Final Office Action, Applicants respectfully request reconsideration in view of the above amendments and the following remarks. Claims 1, 23, 38, and 49 have been amended. No claims have been cancelled or added. Accordingly, claims 1-3, 6-11, 13, 23-38, and 40-51 are pending in the application.

I. Claim Amendments

Applicants have amended claim 1 at line 2 to clarify the language. Applicants have also corrected typographical errors in claim 23 at line 10, claim 38 at line 5, and claim 49 at lines 4 and 10. Applicants do not believe that these amendments affect the scope of the claims.

Further, Applicants have amended claims 1 and 23 to include the limitation of “to transition between the presentation images.” Support for these amendments may be found in the specification at p. 10, lines 7-13.

II. Claims Rejected Under 35 U.S.C. § 103(a)

Claims 1-2, 7-11, 13, 23, 26-27, 29-35 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,301,586 issued to Yang et al. (“Yang”) in view of U.S. Patent No. 6,567,983 issued to Shiimori (“Shiimori”). Claims 24, 43, 44, 46 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Shiimori and further in view of U.S. Patent No. 6,747,674 issued to Asami (“Asami”). Claims 38, 40, 49 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Asami. Claims 6 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Shiimori and further in view of U.S. Patent No. 5,940,806 (incorrectly cited as 5,840,806 in the Final Office Action) issued to Danial (“Danial”). Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Asami and further in view of Danial. Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Shiimori and further in view of U.S. Patent No. 6,892,351 issued to Vasudevan et al. (“Vasudevan”). Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Asami and further in view of Vasudevan. Claims 3 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Shiimori and further in view of U.S. Patent

No. 6,431,448 issued to Nelson et al. ("Nelson"). Applicants respectfully disagree for the following reasons.

To establish a *prima facie* case of obviousness Examiner must show that the cited references, combined, teach or suggest each of the elements of the claims.

Claims 1 and 23, as amended, include "automatically modifying the inconsistent presentation attributes of the plurality of presentation images to transition between the presentation images" (emphasis added). Examiner has not relied upon and Applicants have been unable to discern any part of Yang or Shiimori that teaches these elements. Thus, Yang in view of Shiimori does not teach or suggest each of the elements of claims 1 and 23. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

With regard to claims 38 and 49, Examiner relies on Yang in view of Asami to reject these claims under 35 U.S.C. § 103(a). However, Asami does not constitute a prior art reference under 35 U.S.C. § 103(a) because 35 U.S.C. § 103(c) excludes references which may qualify as prior art under 35 U.S.C. § 102(e), (f), and (g) from being used as a prior art reference under 35 U.S.C. § 103(a). The text of 35 U.S.C. § 103(c) recites that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." See 35 U.S.C. §103(c), MPEP § 706.02(1)(1).

Asami is a U.S. patent assigned to Sony Corporation and the assignment was recorded on January 19, 2000 by the USPTO (Reel 010552/Frame 0630). The subject application was filed on August 11, 2000 and also assigned to Sony Corporation. This assignment was recorded by the USPTO on December 4, 2000 (Reel 011346/Frame 0138). Hence, the cited reference (Asami) and the claimed invention were, at the time the invention was made, both owned by Sony Corporation or subject to an obligation of assignment to Sony Corporation. Asami therefore cannot be a basis of a rejection under 35 U.S.C. § 103(a).

Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 38 and 49 are requested.

Claims 2-3, 6-11, 13, 24-37, 40-48, and 50-51 depend from independent claims 1, 23, 38, and 49, respectively, and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to the independent claims, and because Examiner has not relied upon and Applicants have been unable to discern any part of the cited references that cures the deficiencies of the references cited as to the independent claims, the cited references do not teach or suggest each of the elements of the dependent claims. Moreover, Asami, upon which Examiner relies in rejecting claims 24, 40, 41, 43, 44, 46, 47, 50, and 51, does not constitute a prior art reference under 35 U.S.C. § 103(a), for the reasons discussed above with regard to claims 38 and 49.

Further, Applicants note that Nelson, cited against claims 3 and 25, does not constitute prior art under 35 U.S.C. § 102 and thus cannot form a basis of a rejection under 35 U.S.C. § 103. The present application claims priority from U.S. Provisional Application Serial No. 60/181,779 filed February 11, 2000. Nelson was filed on May 11, 2000, after Applicants' priority date, and therefore cannot be a basis of a rejection under 35 U.S.C. §103(a).

Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

CONCLUSION

In view of the foregoing, it is believed that all claims are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If Examiner believes that a telephone conference would be useful in moving the application forward to allowance, Examiner is encouraged to contact the undersigned at (310) 207-3800. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service, with sufficient postage, as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Amber D. Saunders 3/22/07
Amber D. Saunders Date